

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/039, 176 03/13/98 RINES

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RINES AND RINES  
81 NORTH STATE STREET  
CONCORD NH 03301

WM02/0802

 EXAMINER

DAVIS, TD

 ART UNIT PAPER NUMBER

2652

DATE MAILED:

08/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/039,176	RINES ET AL.
	Examiner David D. Davis	Art Unit 2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 05 July 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 14, 16-20 and 22-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 14, 16-20 and 22-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_.

***Continued Prosecution Application***

1. The request filed on July 5, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/039,176 is acceptable and a CPA has been established. An action on the CPA follows.

***Claim Objections***

2. Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 19 depends from canceled claim 15.

***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

voice-controlled switching means disposed at said steering wheel region and programmed with a plurality of pre-designated separate voice commands for the respective operation of each of said entertainment deck components and also of the cellular radio telephone; the voice-controlled switching means being responsive to the drive speaking the respective pre-designated commands live at said steering wheel region for thereupon effective the activating of the corresponding control switch.

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 5, 2001 have not been approved because they raise the issue of new matter. Specifically, the drawings now show voice commands controlling all the functions of the tape deck and the

cellular radio telephone. The specification at page 16 only supports voice commands for the tape deck, i.e. the drive-expressed words "RECORD" (to actuate REC and PL); "RECORD AND TRANSMIT", (to actuate REC-TX); etc.

*Claim Rejections - 35 USC § 112*

5. Claims 23-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. For example, the language recited in claim 23, lines 9-15:

voice-controlled switching means disposed at said steering wheel region and programmed with a plurality of pre-designated separate voice commands for the respective operation of each of said entertainment deck components and also of the cellular radio telephone; the voice-controlled switching means being responsive to the drive speaking the respective pre-designated commands live at said steering wheel region for thereupon effective the activating of the corresponding control switch.

was not described in the specification at the time the application was filed in such a way as to reasonably convey to a skilled artisan that the inventors had possession of the claimed invention.

6. Claims 14, 16-20 and 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, in line 3 of claim 23 "the driver" is indefinite because it lacks antecedent basis. Similar indefiniteness exists in claims 24 and 25.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14, 26-20 and 22-30 are 103(a) as being unpatentable over Ishikawa et al (US 4,698,838) in view of Dubus (US 4,731,811). Ishikawa et al shows in figure 1 steering wheel region 4 and vehicle cellular radio telephone 2 for use by a driver in a vehicle.

Ishikawa et al is silent, however, as to a voice controlled switching mechanism programmed with and responsive to a plurality of pre-designated separate voice commands for operation of an “entertainment deck” and cellular radio telephone.

Dubus shows in figures 1-3 voice controlled switching mechanism 2 and 3 programmed with and responsive to a plurality of pre-designated separate voice commands for operation of “entertainment deck” 8 and 9 and cellular radio telephone 12.

It would have been obvious to a person having ordinary skill in the art the time the invention was made to provide the cellular radio telephone in the steering wheel of Ishikawa et al with a voice controlled mechanism as taught by Dubus. The rationale is as follows: one of ordinary skill in the art at the time the invention was made would have been motivated to provide a cellular radio telephone in a steering wheel with a voice controlled mechanism to provide a hands-free telephone system. See column 1, line 40 through line 5 of column 2.

***Response to Arguments***

9. Applicants' arguments filed July 5, 2001 have been fully considered but they are not persuasive.

In paragraph 4 on page 3, in response to the claims being rejected under 35 U.S.C. 112, first paragraph,

Applicants have been at a loss to understand this very belated raising of this rejection ten years after the parent application was filed, when the adequacy of such disclosure in the original parent application (unchanged in the present divisional application and drawings) has been continuously recognized and not criticized by the Office.

It should be noted that the claims are rejected not the disclosure. Applicants claimed subject matter has changed, and the specification and drawings do not support these changes.

On pages 4 and 5, applicants quote various portions of the specification and claims in an attempt to support the claimed subject matter. Applicants specifically claim "a plurality of pre-designated separate voice commands for the respective operation of each of said entertainment deck components". The entertainment deck components as defined in the claim include "one or more of storage-medium player, dictation recorder and AM/FM radio-receiver". The

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specification does not support a plurality of pre-designated separate voice commands for the respective operation of each of storage-medium player, dictation recorder and AM/FM radio-receiver. With respect to the drawings, a plurality of pre-designated separate voice commands for the *respective operation* of each of storage-medium player, dictation recorder and AM/FM radio-receiver needs to be shown or deleted from the claims.

Applicants assert on pages 7-9 that the drawings now quote only the specification. However, applicants' amended legend in figure 1 quotes only a phrase of the pertinent sentence on page 16 and locates the legend so that the drawings now show voice commands controlling all the functions of the tape deck and the cellular radio telephone. The specification at page 16 only supports voice commands for the tape deck, i.e. the drive-expressed words "RECORD" (to actuate REC and PL); "RECORD AND TRANSMIT", (to actuate REC-TX); etc.\

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,870,686 to Gerson et al discloses voice switching commands. JP 59-39129 to Umebayashi and JP 64-46355 to Shoji et al discloses a telephone in the steering wheel of a car.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is (703) 308-1503. The examiner can normally be reached on Mon., Tues., Thurs. and Fri. between 7:30-6:00. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900. Any other inquiry should be directed to the customer service center whose telephone number is (703) 306-0377.



David D. Davis  
Primary Examiner  
Art Unit 2652

ddd  
July 16, 2001